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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,392	12/01/2000	Yoshimasa Fujita	900-360	1283
23117	7590	02/24/2004	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/726,392	FUJITA, YOSHIMASA	
	Examiner	Art Unit	
	Patrick D. Niland	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/23/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment of 1/23/04 has been entered. Claims 1-11 and 14-22 are pending.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, 9-11, and 14-22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5958609 Ueda et al..

Ueda et al. discloses the instantly claimed composition at column 14, lines 20-47 and the remainder of the document. Lower polymer molecular weights and higher solvent amounts will necessarily inherently give the instantly claimed viscosities by definition of intrinsic viscosity and inherent viscosity. The argument regarding the ink jet technique is not persuasive as these claims are drawn to the composition, not its method of use. There is no probative evidence that these compositions could not be used as ink jet inks nor that they would not inherently and necessarily give the properties of the newly added claims 21-22. The applicant's argument that the examiner's statement that the

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instantly claimed viscosities are not inherent to the disclosure of the patentee is wrong and unsupported lacks probative evidence to support it. The examiner once again notes column 14, lines 20-47 and the fact that lower molecular weight and lower polymer concentration are known to give lower viscosities based on the concepts of inherent viscosity and intrinsic viscosity and viscosity average molecular weight, which are basic concepts to the ordinary skilled artisan. A large portion of the compositions of the cited portion of the patentee are expected to necessarily and inherently have the instantly claimed viscosity due to the large viscosity range claimed. The claims recite "solvent" which encompasses toluene. Furthermore, page 9 of the instant specification contradicts the applicant's representative's argument with regard to toluene's usefulness as an inkjet solvent. The argument re claim 14 ignores the fact that the claim is directed to a composition, not its method of use. The applicant's argument is directed towards the intended use of the instantly claimed composition. The instant claims are directed towards a composition, not its intended use. The composition is defined solely by its ingredients and the amounts thereof. The instant recitation of the intended use of the composition does nothing to further define the composition to one of ordinary skill in the art. The US Patent and Trademark Office cannot patent claims directed towards a composition which is not novel or is obvious only because the inventor has found a novel use for the composition. See *In re Pearson*, 494 F. 2d 1399, 181 USPQ 641 (CCPA 1974). It is not seen that the patentee does not inherently encompass the parameters of newly added claims 17-20 since the compositions otherwise fall within the scope of these claims. The applicant does not show that the

solvents disclosed by the patentee do not inherently and necessarily possess the instantly claimed vapor pressure. Toluene is not the only solvent disclosed. The applicant's argument re toluene is not commensurate in scope with the patentee's specification therefore and is not persuasive. The statement that the compositions of the patentee are entirely unrelated to those of claims 19-20 lacks basis for the reasons given above. The applicant's argument that Ueda fails to disclose using the cited compositions in an inkjet method ignores the fact that the instant claims are not directed to an inkjet method but to "a coating liquid". It is not seen that the intended use recited excludes the compositions of the patentee because they have not been shown to not be useful in an inkjet coating method inherently and necessarily. Arguments related to the examples of Ueda ignore the above cited section of the patentee and are therefore not persuasive since this rejection relies on the cited part of column 14 of the patentee. Contrary to the applicant's assertions, Ueda is not limited to its examples and the applicant's representative continues to ignore the rejection made by the examiner in favor of citing portions of Ueda not relied on by the examiner. There is no "inkjet" requirement in claim 1. There is the recited intended use which is not a per se requirement. There is no probative evidence that the compositions of the patentee cannot be inkjetted and the applicant's arguments re toluene ignore page 9 of their own specification. The examiner notes no response from the applicant regarding this point made in the prior office action. For these reasons, this rejection is maintained.

5. Claims 1-11 and 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 5958609 Ueda et al..

Ueda et al. discloses the instantly claimed composition at column 14, lines 20-47 and the remainder of the document. Lower polymer molecular weights and higher solvent amounts will necessarily inherently give the instantly claimed viscosities by definition of intrinsic viscosity and inherent viscosity. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed mixture of ingredients to give the instantly claimed viscosities because they are encompassed by the patentee's disclosure and would have been expected to give predictable film properties to the ordinary skilled artisan. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the solvents of the instant claim 8 in the composition of the patentee because they are of similar hydrophile/lipophile balance and vapor pressures as those of the patentee and therefore would have been expected to function similarly as the solvents of the patentee and they are encompassed by the patentee's recitation of "and the like". The argument regarding the ink jet technique is not persuasive as these claims are drawn to the composition, not its method of use. There is no probative evidence that these compositions could not be used as ink jet inks. The claims recite "solvent" which encompasses toluene. Furthermore, page 9 of the instant specification contradicts the applicant's representative's argument with regard to toluene's usefulness as an inkjet solvent. The argument re claim 14 ignores the fact that the claim is directed to a composition, not its method of use. The applicant's argument is directed towards the intended use of the instantly claimed composition. The instant claims are directed towards a composition, not its intended use. The composition is defined solely by its ingredients and the

amounts thereof. The instant recitation of the intended use of the composition does nothing to further define the composition to one of ordinary skill in the art. The US Patent and Trademark Office cannot patent claims directed towards a composition which is not novel or is obvious only because the inventor has found a novel use for the composition. See *In re Pearson*, 494 F. 2d 1399, 181 USPQ 641 (CCPA 1974). It is not seen that the patentee does not inherently encompass the parameters of newly added claims 17-20 since the compositions otherwise fall within the scope of these claims. For these reasons and those cited in paragraph 4 above, this rejection is maintained.

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (571) 272-1121. The examiner can normally be reached on Monday through Thursday from 10 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

February 19, 2004



Patrick Niland

Primary Examiner
Art Unit 1714